

III. REMARKS

Claim Amendments

Claims 1, 3, 5-12, 14-24, 26-27, 29-34 and 36-41 were pending in the present application and are canceled herein. New claim 42 is added. Consideration of the new claim is respectfully requested.

In this Amendment, Applicants have cancelled claims 1, 3, 5-12, 14-24, 26-27, 29-34 and 36-41 from further consideration in this application. Applicants are not conceding that the subject matter encompassed by claims 1, 3, 5-12, 14-24, 26-27, 29-34 and 36-41 prior to cancellation is not patentable over the art cited by the Examiner. Claims 1, 3, 5-12, 14-24, 26-27, 29-34 and 36-41 were cancelled in this Amendment solely to facilitate expeditious prosecution of new claim 42. Applicant respectfully reserves the right to pursue claims including the subject matter encompassed by cancelled claims 1, 3, 5-12, 14-24, 26-27, 29-34 and 36-41, and additional claims in one or more continuing applications.

Support for Claim Amendments

All citations to the specification in the support chart and discussion below refer to the paragraphs, lines, and figures of Applicants' US Patent Publication No. US 2005/0182684 A1.

Features of Claim 42	Support in Specification/Drawings
A method for creating a read-only contract between a buyer and a seller, the method comprising	Par. [0013], lines 1-4; Fig. 4.
the buyer logging on to an e-commerce website of the seller, wherein the e-commerce website displays a product listing for a product	Par. [0037], lines 14-17 ("The information regarding the goods ... most typically will be the same as the description presented on e-commerce website"); Fig. 4.

Features of Claim 42	Support in Specification/Drawings
the product listing comprising: a description of the product; and a price of the product;	Par. [0040], lines 9-12; Fig. 4.
the buyer making a selection to purchase the product; responsive to the buyer making the selection, the seller generating an XML file;	Par. [0037], lines 6-10; Fig. 4.
the seller writing personal information of the seller to the XML file;	Par. [0037], lines 10-21; Fig. 4.
the buyer writing personal information of the buyer to the XML file;	Par. [0037], lines 21-27; Fig. 4.
presenting the XML file to both the buyer and the seller to determine whether the buyer and seller both agree to the contract terms;	Par. [0037], lines 27-28; Fig. 4.
responsive to determining that the buyer and seller do not both agree to the contract terms, modifying the XML file;	Par. [0038], lines 3-6; Fig. 4.
responsive to determining that the buyer and seller both agree to the contract terms, the buyer and the seller convert the XML file into a shopping token by both digitally signing the XML file,	Par. [0038], lines 1-3, 12-15; Fig. 4.
wherein the buyer uses a first private to key to digitally sign the XML file and the seller uses a second private key to digitally sign the XML file	Par. [0040], lines 19-22; Fig 3A; Fig. 3B; Fig. 4.
wherein the shopping token comprises a read-only contract between the buyer and the seller;	Par. [0039], lines 1-4; Par. [0040], lines 2-4;

Features of Claim 42	Support in Specification/Drawings
	Fig. 5.
storing the shopping token on a trusted third party computer; wherein contents of the shopping token cannot be copied by the buyer or the seller; and	Par. [0035], lines 5-7; Par. [0028], lines 5-7; Par. [0036], lines 6-9; Fig. 3B.
wherein an attempt to alter the shopping token renders the shopping token invalid.	Par. [0039], lines 4-6.

Claim Rejections - 35 U.S.C. § 101

Claims 26-36 stand rejected under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. In light of the present cancellation of claims 26-36, these rejections are now moot.

Claim Rejections - 35 U.S.C. § 112, First Paragraph

Claims 1, 3, 5-12, and 37-41 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In light of the present cancellation of claims 1, 3, 5-12, and 37-41, these rejections are now moot.

Claim Rejections - 35 U.S.C. § 112, Second Paragraph

Claims 1, 3, 5-12, 26-27, 29-34, and 36 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which Applicants regard as the invention. In light of the present cancellation of claims 1, 3, 5-12, 26-27, 29-34, and 36, these rejections are now moot.

Claim Rejections - 35 U.S.C. § 103, Obviousness

1.) Claims 1, 3-9, 14-21, 26-33, and 37-38 stand rejected under 35 U.S.C. § 103 as being obvious over Albazz (US 2002/0042782) in view of Conant (US2002/0129056) in further view of Conklin (US 6,141,653). In light of the present cancellation of claims 1, 3-9, 14-21, 26-33, and 37-38, these rejections are now moot. However, Applicants discuss the cited Albazz/Conant/Conklin combination below in reference to new claim 42.

2.) Claims 10-12, 22-24, 34-36 and 39-41 stand rejected under 35 U.S.C. § 103 as being obvious over Albazz in view of Conant in view of Conklin in further view of Moss (US 2005/0160014). In light of the present cancellation of claims 10-12, 22-24, 34-36 and 39-41, these rejections are now moot.

Discussion of New Claim 42

Summary of the Presently Claimed Invention

Claim 42 provides a method of “creating a read-only contract between a buyer and a seller” in an e-commerce transaction. An important feature of claim 42 is that the contract, once signed by both parties, the parties can still read the contract, but the contract is unmodifiable and its contents cannot be copied, such that the signed contract serves as conclusive proof of the terms of the transaction. Par. [0013], line 1 – Par. [0014], line 15.

Another important feature is that the contract contains the description of the product that was displayed to the buyer on the seller’s e-commerce website. Par. [0037], lines 14-17. This is important because it allows the buyer to contest the transaction in the future if the product delivered by the seller does not satisfy the description that induced the buyer to purchase the product, even if the seller did satisfy the price and quantity terms of the contract.

Features of Claim 42 Not Found in the Cited Combinations

1.) Claim 42 requires that “the e-commerce website displays a product listing ... comprising: a description of the product.” Furthermore, claim 42 recites “the seller writing contract terms to the XML file, the contract terms comprising: the product listing...” Thus, claim 42 requires that the contract contain the description of the product that was displayed on the website.

The Examiner states that “Albazz, Conant, and Conklin collectively teach various types of contract elements such as price (Conant, abstract) deliver/shipping methods and payment methods (Albazz, 0008), and quantity (Conant, abstract).” Office Action p. 12. However, the cited combination does not teach making a description of the product part of the contract, wherein the description of the product is the same description that was displayed on the website. “The Examiner asserts that the specific types of contract elements do not move to distinguish the claimed invention.” *Id.* Applicants disagree, however, because including such a product description in the contract provides buyers with increased protection against fraud in e-commerce transactions. This is an important feature of claim 42 because it provides the buyer with protection against a “bait and switch” where the seller describes the product on the website in one way, but delivers a product not satisfying that description.

In the discussion of cancelled claim 3, the Examiner states that Albazz in view of Conant and Conklin “information regarding a good.” Office Action p. 13 (citing Albazz [0043]-[0044]). The cited portion of Albazz discusses “a list of products or services” and “prices, incentives, payments and other financial terms and conditions” but does not disclose creating a contract which includes a product description that was displayed on the e-commerce website. Applicants submit that the “information regarding a good,” which the Examiner alleges is taught by the

Albazz/Conant/Conklin combination, is not the same as “the product listing” of claim 42, which must be the same product listing that was displayed on the website. The requirement of including the product listing that was displayed on the website adds a level of protection for the buyer that is not present by simply including the “information regarding a good” which the Examiner alleges is taught by Albazz/Conant/Conklin.

2.) Claim 42 requires “wherein the buyer uses a first private to key to digitally sign the XML file and the seller uses a second private key to digitally sign the XML file.” The cited combination does not expressly teach the buyer and seller using different private keys to sign the contract. The cited combination merely discloses using digital signatures (e.g. Albazz [0025], [0043], [0097], but does not disclose wherein the buyer and seller each have their own private key.

3.) Claim 42 requires “storing the shopping token on a trusted third party computer.” The feature of the Albazz/Conant/Conklin combination found in Albazz [0088] only teaches storing the contract at the seller’s computer.

4.) Claim 42 requires “wherein the contents of the contract cannot be copied by the buyer or the seller.” The feature of the Albazz/Conant/Conklin combination found in Albazz [0016] and [0086] (cited at Office Action p. 10) only teaches locking the contract “to prevent unilateral amendment by either party.” This is not the same as preventing copying of the contract. Even if a contract is locked such that it cannot be altered, that does not mean it cannot be copied and pasted into another document, wherein the copy of the contract is then altered.

5.) Claim 42 requires that the contract be “read-only.” However, the Albazz system, upon which the cited combination is based, teaches a contract with dynamic elements that may

be unilaterally altered after it is digitally signed. Albazz [0025], lines 10. A contract that can be unilaterally altered is not “read-only.”

6.) Claim 42 recites “wherein an attempt to alter the shopping token renders the shopping token invalid.” The Examiner did not cite any reference/combination as teaching this feature or anything similar (in the rejection of claim 26, the Examiner stated that claim 26 is rejected for the same reason as claims 1, 3, 5-9, but this feature was not found in cancelled claims 1, 3, 5-9.). Applicants submit that this feature is not found in Albazz, Conant, or Conklin, either alone or in combination.

Because the cited combination does not teach at least these features of claim 42, Applicants respectfully request that it be allowed.

The Cited Combination Cannot Achieve the Same Result as Claim 42

The Albazz system, to which the Examiner added features of Conant and Conklin to create a combination, creates a contract that “comprises dynamic elements which can be unilaterally altered by either the seller or the buyer.” Albazz [0025], lines 8-10. Simply because Albazz includes static elements does not mean that the Albazz/Conant/Conklin combination does not also include these dynamic elements. The Albazz reference is the basis for the cited combination, and one of the main features of Albazz (dynamic elements) renders it inoperative to accomplish the same result as claim 42, namely a contract that cannot be unilaterally altered by either party after it is digitally signed by both parties.

For at least the foregoing reasons, Applicants respectfully request that new claim 42 be allowed.

CONCLUSION

Applicant submits that the claims are now in condition for allowance.

Respectfully submitted,

A handwritten signature in cursive script that reads "Rudolf O. Siegesmund". The signature is written in dark ink and is positioned above a horizontal line.

Rudolf O. Siegesmund
Registration No. 37,720
Gordon & Rees LLP
Suite 2800
2100 Ross Avenue
Dallas, Texas 75201
214-231-4660
214-461-4053 (fax)
rsiegesmund@gordonrees.com